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09/944,659	08/31/2001	Christopher A. Mesa	10017722-1	1784

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Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHUONG, TRUC T

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2179

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,659
Filing Date: August 31, 2001
Appellant(s): MESA ET AL.

Steven R. Ormiston
For Appellant

EXAMINER'S ANSWER

Art Unit: 2151

This is in response to the appeal brief filed 08/22/07 appealing from the Office action mailed 02/15/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Patent No. 5,799,070

Monty et al.

08-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a computer readable medium as claimed in claims 28 and 31 is not specifically defined what exactly the computer readable medium is from a list of hardware and devices listed in the specification (pages 18-19). The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrase used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Claim Rejections - 35 USC § 102

2. Claims 23-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Monty et al. ("Monty", U.S. Patent No. 5,799,070).

As to claim 23, Monty shows a scanning method, comprising:

displaying a user interface (fig. 1 shows the front panel 10 of the fax machine using the programmed dialing the fax numbers, e.g., col. 3, lines 28-33) from which one or more of multiple destination devices (the receiving fax, e.g., col. 3, lines 40-45) may be selected to receive data from an input peripheral having a scanning capability (the fax machine will make

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the connection with the receiving fax and scanning the document when the receiving fax is ready, e.g., col. 3 lines 27-48);

the input peripheral notifying a selected destination device that the device has been selected to receive data (e.g., col. 3 lines 40-44);

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (e.g., col. 3 lines 30-67);

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Monty clearly teaches that the input device/fax only start scanning and transmitting the document when the destination device is ready/established to receive scanned/faxed data, e.g., col. 3 lines 35-48).

As to claim 24, Monty shows the method wherein the input peripheral comprises a scanner or a multifunction peripheral (fax machine, e.g., col. 3 lines 44-48).

As to claim 25, Monty shows the method further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (a resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1).

As to claim 26, Monty shows the method wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data (programmed dial stored

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numbers in memory, e.g., col. 3 lines 30, and 49-62); Monty also teach an email address to send the data (column 3, lines 35-48).

As to claim 27, Monty shows scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices (Note the rejection of claim 23 above) may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (the resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1) may be selected to receive data from an input peripheral having a scanning capability (the fax machine will make the connection with the receiving fax and scanning the document when the receiving fax is ready, e.g., col. 3 lines 27-48);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (e.g., col. 3 lines 40-44);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (e.g., col. 3 lines 30-67); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty clearly teaches that the input device/fax only start scanning and transmitting the document when the destination device is ready/established to receive scanned/faxed data, e.g., col. 3 lines 35-48).

As to claims 28-31, they are the equivalent claims to method claims 23-25, and 27 respectively and are rejected under a similar rationale.

(10) Response to Argument

The Monty Reference teaches:

A fax/facsimile machine which is operated by a user, using a dialing mode to enter/select numbers/destination addresses of other facsimiles/devices utilizing a front panel 10 of the fax machine (col. 3 lines 28-33, and fig. 1), or the fax machine can be programmed to perform different dialing techniques such as programmed dialing, monitor dialing, and speed dialing (e.g., col. 4 lines 40-60), which the user may select a 1 or 2 programmed digit speed dial location corresponding to either a single sequence of one or more digits or symbols or a group of identifier (which are clearly representing one or more destination/receiving devices, facsimiles, printers, etc). The fax machine will make connection(s) with the selected destination devices, and that fax machine only starts scanning and transmitting the document when the destination device(s) is ready/established to receive scanned/faxed data from the fax machine (col. 3 lines 35-48).

Appellant's Arguments:

a. Appellant alleges that Monty does not show two tiered system (e.g. recipient and application associated with recipient), and the Appellant also alleges that selecting/dialing a fax number or a group of identifier of other devices is not an act of selecting the resource on the destination device.

The Appellant argues that Monty does not have two tiered destination selection system (e.g., recipient and application associated with recipient or the selected destination device and its resource of that destination device such as PC email, PC Fax, PC AppName, etc.); however, that does not seem to be clearly claimed, and

the Appellant is reading limitations from the specification into the claims.

According to the Appellant arguments, the resource on one or more multiple destination devices is/are selected by the user who first selected the one or more destination devices; however, according to a conventional facsimile system (Monty's system), a user could have selected a destination fax server (e.g., company fax center/central fax, or E-fax) to receive a document from a sending peripheral device (scanning/sending fax) without selecting the resource on one or more destination device. However, upon the receiving of the fax document, the server is configured automatically to select recipient/resource of the document and notify that recipient/resource the fax has arrived and ready for review. The claimed limitation has not restricted to the user has to select BOTH one or more destination devices and one or more resource on the destination devices; and it is broad enough for a skilled in the art to interpret as upon the receiving of the fax document, the server is configured automatically to select the recipient (resource) of the document and notify the recipient (resource) that the fax has arrived and ready for review.

b. Appellant disagrees with Examiner about the claim objection of the specification under Rule 1.75(d)(1) as failing to provide antecedent basis of the claimed subject matter.

The claim objection is a petitionable matter, and the Appellant fails to provide antecedent basis or definition to support the terminology "computer readable medium" as claimed. The Appellant has to provide an evidence that the

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“computer readable medium” is any of “memory 408, disk drive 410, floppy disk drive 412 or CD ROM drive 414” (specification fig. 4). If there is/are what the Appellant intend to cover or to provide support, the Examiner suggests the Appellant to redefine or to amend the specification include “computer readable medium” is at least one of the “memory 408, disk drive 410, floppy disk drive 412 or CD ROM drive 414.”

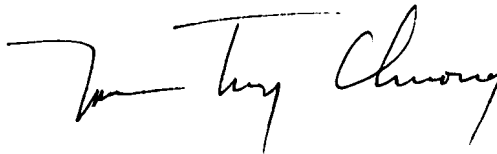
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Truc T. Chuong
Patent Examiner, AU 2179




November 24, 2007

Conferees:

/Lynne H Browne/
Lynne H Browne
Appeal Practice Specialist, TQAS
Technology Center 2100

SPE. Weilun Lo
AU 2179



WEILUN LO
SUPERVISORY PATENT EXAMINER